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Anthony Aquila

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EXAMINER

ALTSCHUL, AMBER L

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/825,604
Filing Date: April 03, 2001
Appellant(s): AQUILA ET AL.

Young A. Tang
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 30, 2008 appealing from the Office action mailed October 9, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUND(S) OF REJECTION

Claims 25 and 73-82 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25 and 73-82 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

Claims 25 and 73 recite a "computer implemented method of determining a type of assignee or selecting a type of assignee" which fails to (1) be tied to another statutory class and (2) transform underlying subject matter. Although the claims recite a "computer implemented" method, this is just a nominal recitation of a physical structure and fails to satisfy the statutory requirements. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Furthermore, no transformation of any physical object is completed during the recitation of the present invention. As such, the present invention is directed towards non-statutory subject matter and is rejected under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 25, 73-78, 80-82, 84-89, and 91-93 are rejected under 35 U.S.C. 102(e) as being anticipated by Loveland, U.S. Patent No. 6,810,383.

4. As per claim 25, Loveland teaches a computer-implemented method of determining a type of assignee to whom to assign an insurance claim, the method comprising: receiving data related to the insurance claim, the data comprising a plurality of data elements, a data element serving as an assignment criterion (see column 14, lines 3-14); assigning a score to a first and second data elements based on scoring rules, wherein each data element includes one or more data from the group consisting of policy information, repair cost, and location of incident (see column 14, lines 35-44); determine an overall score of the insurance claim based on the assigned scores (see column 15, lines 2-9, the Examiner interprets the final result of project parameters being defined and appropriate rules applied to be a form of overall score of the claim); determining a class of the insurance claim according to classing rules (see column 14, lines 37-39, the Examiner interprets type of loss to be a form of class of insurance claim); determining a type of assignee to whom to assign the insurance claim according to the application of business rules to the overall score of the insurance claim and the class of the insurance claim, wherein the business rules weight the class more highly than the score (see

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column 15, lines 22-28, column 15, lines 38-67 and column 16, lines 1-5, the type or class of claim is weighted more highly because only those service providers who are qualified to perform the project are matched based on the assignment process).

5. Claims 73-74, 76-77, and 81 contain substantially similar limitations to those already addressed in claim 25 and, as such, are rejected for similar reasons as given above.

6. As per claim 75, Loveland teaches the method of claim 73 as described above. Loveland further teaches the claim score reflects a severity of the insurance claim (see column 14, lines 42-43).

7. As per claim 78, Loveland teaches the method of claim 73 as described above. Loveland further teaches an assignee comprises an element of a group comprising a repair facility (see column 11, lines 46-49).

8. As per claim 80, Loveland teaches the method of claim 73 as described above. Loveland further teaches an effect of the first data element on the claim score is greater than an effect of the second data element on the claim score (see column 15, lines 38-57).

9. As per claim 82, Loveland teaches the method of claim 73 as described above. Loveland further teaches determining a first set of profiles, wherein each profile in the first set represents a potential assignee of the determined type, and wherein each profile in the first set includes a profile score (see column 15, lines 52-57); determining a second set of profiles, wherein the second set contains profiles in the first set that have the highest profile scores, and wherein each profile in the second set includes a measure of capacity to complete the insurance claim (see column 15, lines 58-67); and determining, from the second set of profiles, a profile with the largest measure of capacity (see column 16, lines 1-3).

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10. Claims 84-89 and 91-93 contain substantially similar computer program product limitations to method claims 73-78 and 80-82 and, as such, are rejected for similar reasons as given above.

(10) Response to Argument

In the appeal brief filed May 30, 2008, Appellant makes the following arguments.

Claims 25, 73-76, 78, 80-82, 84-87, 89, and 91-93

(A) Loveland fails to teach or suggest “assigning a score to data elements” limitation recited in finally rejected claims 25, 73, and 84.

(B) Loveland fails to teach or suggest “determining an overall score of insurance based on assigned scores” limitation recited in finally rejected claims 25, 73, and 84.

(C) Loveland fails to teach or suggest “determining a type of assignee based on the overall score and class of the insurance claim, and also weighting class more highly than the score” limitation recited in finally rejected claims 25, 73, and 84.

(D) Appellant argues that claims 74-76, 78, and 80-82 depend from and add additional limitations to claim 73. Appellant further argues that Loveland does not identically disclose every single feature recited in claims 74-76, 78, and 80-82.

(E) Appellant argues that claims 85-87, 89, and 91-93 depend from and add additional limitations to claim 84. Appellant further argues that Loveland does not identically disclose every single feature recited in claims 85-87, 89, and 91-93.

(F) Appellant argues that claims 77 and 88 contain substantially similar limitations to those already addressed in finally rejected claim 25.

Argument (A):

As set forth in the previous Office Action mailed Examiner maintains that this feature/element is well known in the art as evidenced by Loveland. In response to Appellant's

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first argument that Loveland fails to disclose assigning a score to data elements, the Examiner respectfully disagrees. It is readily apparent that Loveland suggests assigning a score to data elements, (see column 14, lines 3-14 and lines 35-44, column 15, lines 2-9). Examiner interprets the final result of project parameters being defined and appropriate rules applied to be a form of overall score of the claim.

Argument (B):

As set forth in the previous Office Action mailed Examiner maintains that this feature/element is well known in the art as evidenced by Loveland. In response to Appellant's second argument that Loveland fails to disclose determining an overall score of insurance based on assigned scores, the Examiner respectfully disagrees. It is readily apparent that Loveland suggests determining an overall score of insurance based on assigned scores, (see column 14, lines 3-14 and lines 35-44, column 15, lines 2-9). Examiner interprets the final result of project parameters being defined and appropriate rules applied to be a form of overall score of the claim.

Argument (C):

As set forth in the previous Office Action mailed Examiner maintains that this feature/element is well known in the art as evidenced by Loveland. In response to Appellant's third argument that Loveland fails to disclose determining a type of assignee based on the overall score and class of the insurance claim, and also weighting class more highly than the score, the Examiner respectfully disagrees. It is readily apparent that Loveland suggests determining a type of assignee based on the overall score and class of the insurance claim, and also weighting class more highly than the score, (see column 14, lines 3-14 and lines 35-44, column 15, lines 2-9, lines 22-28, and 38-67, column 16, lines 1-5). Examiner interprets the

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type or class of claim is weighted more highly because only those service providers who are qualified to perform the project are matched based on the assignment process.

Argument (D):

In response to Appellant's fourth argument that Loveland does not identically disclose every single feature recited in claims 74-76, 78, and 80-82. Appellant's argument that the cited reference does not disclose certain features of the claimed invention merely amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Appellant has simply cited a portion of the reference and concluded that, based on the citation, the reference does not disclose the claimed invention. Appellant has provided no reasons **why** the cited reference does not disclose the claimed feature.

Argument (E):

In response to Appellant's fifth argument that Loveland does not identically disclose every single feature recited in claims 85-87, 89, and 91-93. Appellant's argument that the cited reference does not disclose certain features of the claimed invention merely amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Appellant has simply cited a portion of the reference and concluded that, based on the citation, the reference does not disclose the claimed invention. Appellant has provided no reasons **why** the cited reference does not disclose the claimed feature.

Argument (F):

In response to Appellant's sixth argument that Loveland does not identically disclose every single feature recited in claims 77 and 88. Appellant's argument that the cited reference does not disclose certain features of the claimed invention merely amounts to a general

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allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Appellant has simply cited a portion of the reference and concluded that, based on the citation, the reference does not disclose the claimed invention. Appellant has provided no reasons **why** the cited reference does not disclose the claimed feature.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any

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amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Amber L. Altschul/

Examiner, Art Unit 3626

Amber L. Altschul

/C Luke Gilligan/

Supervisory Patent Examiner, Art Unit 3626

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Conferees:

/CLG/

Christopher L. Gilligan

Supervisory Patent Examiner, Art Unit 3626

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Vincent Millin /VM/

Appeals Practice Specialist

Vincent Millin

Appeals Practice Specialist

/Wynn W. Coggins/

Director, TC 3600